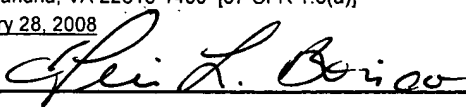


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)  
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 22310-RA	
<p>I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as Express Mail – Label No. <u>EM 180497933US</u> in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 [37 CFR 1.8(a)] on <u>February 28, 2008</u></p> <p>Signature: <u></u></p> <p>Typed or printed name: <u>Teri L. Bonica</u></p>		Application Number <b>10/625,716</b>	Filed <b>July 23, 2003</b>
		First Named Inventor <b>LINSKY, Stacie et al.</b>	
		Art Unit <b>3765</b>	Examiner <b>HALE, Gloria M.</b>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number: <u>59,717</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*</p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

  
Signature

George P. Bonanto  
Typed or printed name

Telephone Number: (770) 541-7444

Date: February 28, 2008

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Application Serial Number: 10/625,716  
Attorney Docket No. 22310-RA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	LINSKY, <i>et al.</i>	)	
		)	
Serial No.:	10/625,716	)	Examiner: HALE, Gloria M.
		)	
Filed:	July 23, 2003	)	Art Unit: 3765
		)	
For:	Apparatus and Method for	)	Conf. No.: 8128
	Facilitating Breast	)	
	Self-Examinations	)	

Mail Stop: Amendments  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

February 28, 2008

**NOTICE OF APPEAL AND PRE APPEAL BRIEF REQUEST FOR REVIEW**

Dear Madam,

Responsive to the Office Action dated December 28, 2007 ("the Office Action"), Applicants submit herewith a Notice of Appeal, a Pre-Appeal Brief Request for Review form (PTO/SB/33), remarks, and a check for the requisite fee.

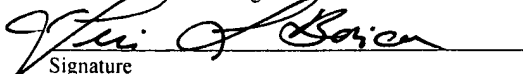
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I hereby certify that this correspondence is being deposited with the United States Postal Service Express Mail Label No. **EM 180497933US** with adequate postage in an envelope addressed to: Commissioner for Patents, Mail Stop Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, on the following date:

**February 28, 2008**

**Teri Bonica**

Name of Person Mailing



Signature

**February 28, 2008**

Date

## REMARKS

Claims 1-5, 8, and 28 stand rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent Number 5,479,661 to Fingleson *et al.* (“Fingleson”).

As to claims 1-5 and 8, Applicants respectfully submit that Fingleson fails to teach “a form-fitting garment comprising armpit areas”, as claimed. Specifically, Fingleson fails to teach a “form-fitting” garment<sup>1</sup>. The device of Fingleson allows insertion of a hand between the user’s body and the device, and is thus not “form-fitting”. Furthermore, Fingleson fails to teach “armpit areas”<sup>2</sup>. Instead, Fingleson merely teaches a fabric, paper, or plastic bib (see col. 3, lines 2-3 and Figs. 1, 2, 4, 6, and 8), having “open sides” (see e.g. col. 4, line 19) through which a user may insert a hand to perform an examination underneath the bib (see e.g. FIG. 8 and col. 2, lines 24-27 and col. 4, lines 19-21). As such, Fingleson fails to teach a shirt, and fails to teach anything regarding the thickness of the material from which the garment is formed or the lubricity of such material. This is not unexpected, however, since Fingleson does not contemplate an examination of breast, or any other, tissue from an outside of the garment. To conclude otherwise is clearly erroneous.

Nonetheless, the Examiner stated, at page 2 of the Office Action, that “[t]he Fingleson apparatus comprises a low coefficient of friction since it allows the movement of the hands on the surface of the garment about the breasts with the examination pattern disposed on the garment so that it overlies a breast of the wearer as claimed in claims 3 and 4. (See Fingleson col. 3, line 35- col. 4, line 23).” A careful reading of the cited section, however, reveals that, in fact, Fingleson is completely devoid of any reference to the level of friction of the material for the garment. Instead, Fingleson states that the garment may be formed of paper or plastic, which materials are not only not form-fitting, but do not have a low coefficient of friction to facilitate hand and finger movement over an examination pattern.

As to claim 28, Applicants respectfully submit that Fingleson further fails to teach the step of examining the breast from the outside of the garment, as required by the claim. Specifically, and directly to the contrary, Fingleson teaches examining the breast from inside the garment (see col. 4,

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1 The claim element “form-fitting” is 1) defined in the written description at page 7, lines 18-23, at page 9, lines 16-19, and at page 13, lines 13-21 as conforming to the body; 2) shown in FIG. 5 as conforming to the body; and 3) defined by Merriam-Webster as “conforming to the outline of the body: fitting snugly” (See Exhibit A attached to Applicants’ response filed Oct. 1, 2007).

2 The Examiner admits that Fingleson fails to teach a garment comprising armpit areas. See page 4, line 3.

lines 11-20 and FIG. 8). At page 3 of the Office Action, the Examiner stated “the wearer of Fingleson et al would palpitate the breast from ‘outside the garment’ wherein the term ‘outside the garment’ is considered to be away or outside the garment material.” Applicants respectfully submit that Applicants’ claim language and specification preclude the interpretation adopted by the Examiner. Specifically, it appears that the Examiner is reading the phrase “outside the garment” to mean “exterior to the fabric of the garment, whether on a side towards the wearer or on a side away from the wearer. Since the garment does not have an “inside”, according to the Examiner’s interpretation of the claim language, i.e. a wearers hand cannot be disposed “inside” the garment fabric, the Examiner’s interpretation is untenable. The only reasonable interpretation of the claim language “outside the garment” is the intended interpretation, i.e. from a side on which the pattern is printed and which is visible to the wearer during use.

Thus, since Fingleson fails to teach each and every limitation of at least claims 1, 2, 3, and 28, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-5, 8, and 28 under 35 U.S.C. 102(b).

35 U.S.C. §103

**Fingleson and Morrison**

The Office Action rejected claims 7, 11-14, and 16 under 35 U.S.C. 103(a) as being unpatentable over Fingleson in view of United States Patent Number 4,873,982 to Morrison (“Morrison”).

As to claim 7, Applicants respectfully submit that Morrison does not remedy the deficiencies of Fingleson with regard to the teaching of armpit areas. Specifically, Morrison does not teach a garment with armpit areas, but merely teaches a “tube top”, which does not extend over the armpit region of the wearer. *See* Figs. 1 and 3, and col. 3, line 62. Nonetheless, the Examiner stated, at page 4 of the Office Action, that Morrison teaches, “that the garment is adapted for use in other areas of the body where the detection of lumps is desired (such as the underarm area). (See Morrison, col. 4, lines 18-27).” The cited section of Morrison, however, does not teach using the garment for examination of the lymph nodes in the armpit area, but merely indicates that, broadly speaking, the inventive multi-ply construction of the device of Morrison may be used with “suitable garments. . . specifically adapted for use with other parts of the body.” The only teaching of an examination

pattern disposed on an armpit area of an examination garment comes from Applicants' own disclosure, and thus, it is clear that the Examiner has used impermissible hindsight in formulating the rejection. Simply put, the vague teaching of Morrison is insufficient to support the Examiner's conclusion of obviousness, and fails to specifically teach the claimed armpit areas.

As to claims 11-14 and 16, Applicants respectfully submit that Fingleson and Morrison, as combined, fail to teach each and every element of the claims, and that the Examiner's conclusion of obviousness relies on impermissible hindsight at least for the reasons stated above as to claim 7. Namely, neither Fingleson nor Morrison teaches an armpit examination pattern disposed on a form-fitting garment. Furthermore, neither cited reference teaches a garment having two separate examination patterns for examination of separate areas of the wearer's body.

With regard to claims 12 and 13, Applicants respectfully submit that Fingleson and Morrison fail to teach that the garment is a shirt formed from a thin material, or that the garment comprises a low coefficient of friction to facilitate hand and finger movement *over the examination patterns*. As discussed above, Fingleson fails to teach these elements, and Morrison fails to remedy such deficiency. Specifically, the device of Morrison is not a shirt, and does not have the claimed armpit areas. Furthermore, while Morrison discusses frictional considerations, Morrison is concerned only with friction between contacting surfaces of adjacent plies, and teaches nothing with regard to a level of friction between the user's hand and fingers over an examination pattern on the outside of the device<sup>3</sup>. See col. 2, lines 35-44.

### **Fingleson and Rusin**

The Office Action rejected claims 9, 10, 19-23, 25-27, and 29 under 35 U.S.C. 103(a) as being unpatentable over Fingleson in view of United States Patent Number 6,412,491 to Rusin ("Rusin").

As to claims 9, 10, and 29, Applicants respectfully submit that Rusin fails to remedy the deficiencies of Fingleson, i.e. the failure to teach armpit areas and the failure to teach examination from outside the garment. Rusin merely teaches a planar film, which is not a form-fitting garment,

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<sup>3</sup> This distinction is significant because the device of Morrison works by sliding interaction between the first and second ply, wherein the fingers of a user "stick" to the outside surface of the outer ply. Accordingly, this teaches away from Applicants' outer surface having a low coefficient of friction surface to facilitate hand and finger movement thereover.

and does not comprise an armpit area extending over an armpit region of a user. *See* Fig. 1<sup>4</sup>. Thus, the cited teachings of Rusin are irrelevant inasmuch as the Examiner has failed to establish where the prior art teaches a form-fitting garment comprising armpit areas.

As to claim 19, Fingleson and Rusin fail to teach a t-shirt element. Neither the bib of Fingleson, nor the planar film of Morrison can reasonably be construed to teach a t-shirt, and neither allows the same function as a t-shirt. Specifically, the bib of Fingleson is intended to be used with a hand underneath the garment, and the planar film of Morrison lacks the positioning and secure attachment features provided by the t-shirt of the present invention. Furthermore, neither provides the comfort and ease of use provided by the t-shirt examination device of the present invention.

With regard to claims 20 and 21, Fingleson and Rusin further fail to teach the thin material or the low coefficient of friction for facilitating movement of the user's hand and fingers over an examination pattern.

#### **Fingleson, Morrison, and Rusin**

The Office Action rejected claims 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Fingleson in view of Morrison, and further in view of Rusin.

As discussed above, Fingleson, Morrison, and Rusin all fail to teach the form-fitting garment having an armpit examination pattern. Thus, at least for that reason, the rejection of claims 17 and 18 is improper.

Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1-5, 7-14, 16-23, and 25-29.

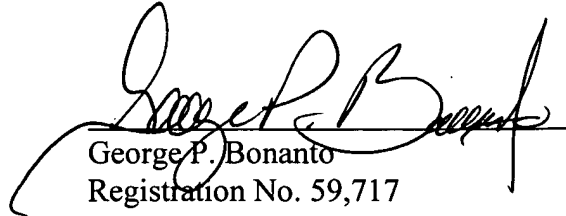
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<sup>4</sup> While Fig. 2 may appear to show the device covering an armpit region of a user, no specific teaching is made to that effect. Furthermore, the film cannot be construed as including a specific "armpit area" specially designed for use with the user's armpit region. Finally, the film of Rusin is non-elastic, and thus is unsuitable use with the contours of a user's armpit region. *See* Abstract, for example.

CONCLUSION

If Examiner has any questions regarding this document, Applicants ask that Examiner contact Applicants' undersigned attorney.

Respectfully submitted,



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